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Art Unit 3638 Examiner Milton Nelson, Jr. Paper No.
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENTS APPEALS AND INTERFERENCES

Applicant: Ernesto Cohan

Serial No.: 10/666/439

APPLICANT'S BRIEF ON APPEAL

Filed: 09/22/2003

Commissioner For Patents
Post Office Box 1450 - Mail Stop AF
Alexandria, VA 22313-1450

Sir:

The following is Applicant's brief on appeal pursuant to 37 C.F.R. 41.37,
and is being filed concurrently with Applicant's Notice of Appeal. The Brief fee is
transmitted herewith.

REAL PARTY IN INTEREST

The real party in interest is the applicant, Ernesto Cohan.

RELATED APPEALS AND INTERFERENCES

To the best of knowledge of Applicant, his legal representatives, and
assignee, there are no applications, appeals, interferences, or judicial proceedings
which may be related to the present appeal, or have a bearing on the Board's decision
in the present appeal.

STATUS OF CLAIMS

Claims 1 through 4, inclusive, and claims 7 and 8 have been canceled.

Claims 5 and 6 are withdrawn from consideration. Claims 9 and 10 are rejected.

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STATUS OF AMENDMENTS

A single amendment has been filed subsequent to final action at the suggestion of Examiner canceling non-related subject matter from the specification.

SUMMARY OF THE CLAIMED SUBJECT MATTER

The presently claimed subject matter relates to an improved ready-made textile cover for upholstered furniture of a type which includes a separate cushion cover element having a novel means to allow stretching of that portion of the seat cover which overlies the upper surface of a seat cushion forming part of the upholstered furniture when the cushion is sat upon. The means also serves to return the stretched portion to its original condition when the user arises. The means is incorporated into a rear side panel which is concealed from view when the cover is installed. The rear panel of that part of the cover which encloses the cushion is made in two portions disposed at a mutual angle. This construction is best understood from a consideration of Figure 1 in the drawing, reference characters 35 and 36. Referring to the specification, the purpose of this construction is described in page 2, line 10, *et. seq.*, and page 5, line 16, *et. seq.*, as well as page 6, line 8, *et. seq.*.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Rejection Under 35 U.S.C. 112

Claims 9 and 10 stand rejected under 35 U.S.C. 112 as being indefinite, the Examiner stating that it is not clear whether claim 9 is directed to the cover or a combination of cover and upholstered furniture.

Claim Rejections 35 U.S.C. 102

Claim 9 is rejected as anticipated by a single reference to Cook.

Claim Rejections 35 U.S.C. 103

Claim 10 is rejected on Cook in view of Reilly for the disclosure of an elongated tube employed to hold parts of a cover in position.

ARGUMENT

Claim Rejections 35 U.S.C. 112

Examiner has rejected claim 9 stating, in essence, that it is unclear whether the claim is directed to the combination of a cover and a sofa or the sub-combination of a cover for use with a sofa. Examiner states that line 9 appears to set forth the sub-combination which is, in fact, the case. He states, however, that lines 4 to 5 appear to set forth the combination. He refers to "overlying a rectangular cushion forming part of the sofa". It is noted by application that this is merely a functional relationship between the cover and sofa and not a positive claiming of the sofa as part of a combination. At no point in the claim does Applicant indicate a combination of cover and sofa.

Examiner has also objected to the specification because of the presence of an amendment which supplied an abstract related to another application. Applicant has filed an amendment requesting cancellation of this subject matter.

Claims Rejections 35 U.S.C. 102

Examiner has stated that claim 9 is rejected as anticipated by Cook (3,371,957). He notes that the hollow shell is made of resilient fabric and notes that elastic means is present as is a rear panel having first and second parts (A_2) disposed in separate planes (note the nearly parallel planes). He further notes that the first and second parts disposed in separate planes at a mutual angle inherently provide a degree

of excess material in an area at the rear of the cushion wherein the material comprising the first and second parts is normally concealed from view. He states that the nature of the resilient material forming the excess material moves over the cushion when sat upon by a user. The resilient nature of the material necessarily contracts when the cushion is vacated.

In response, Examiner admits that whatever stretching is possible is because of the resilient nature of the material from which the cover is made. This is not the case in Applicant's construction, wherein the two parts of his back panel are disposed at a mutual angle which actually provides additional material which is used to allow stretching when required. The stretching does not depend on elasticity of the material, but rather, the two-part rear panel provides additional cloth which is returned to its initial position by the resiliency of the cushion when the seat is vacated.

To achieve full anticipation on a single reference under Section 102, it is submitted that the claim be readable on the reference, or substantially so, or at least the reference suggest what Applicant is doing. It is submitted that Examiner has not sustained this burden.

Claim Rejections 35 U.S.C. 103

Examiner has rejected claim 10 (as best understood) as being unpatentable over Cook, above-discussed, in view of Reilly (5,722,723). Examiner states that Cook shows all the claimed features of the instant invention with the exception of a resilient - elongated tube positioned over the excess material. He notes the discussion of Cook in the above rejection, and states that Reilly, et. al. conventionally teach providing a resilient elongated tube (Figures 8 and 9) as

positioned over excess material formed by the first and second parts. Examiner states that it would have been obvious to one having ordinary skill in the pertinent art to which the invention pertains to modify the primary reference in view of the teachings of the secondary reference by adding the tube member (40), and positioning it over the excess material formed by the first and second parts. Examiner states that this modification stabilizes the cover of Cook by pressing on the excess material, thereby reducing movement of the cover. This inherently distributes stresses over the surface of the cover, including the width, to provide a contractive force through the first and second parts.

In response, the bulk of the argument advanced by Applicant relative to the Section 102 rejection applies. The use of resilient tubes in one form or another in covers for the purpose of keeping excess material concealed from view at various positions of the cover is known. However, the use of the tube in Applicant's construction serves to limit the stretch to the first and second parts of the rear panel of the cover, since the restorative force of the seat cushion would not act upon the excess material, which is not part of the back panel. It is noted that claim 9, without the limitation of the tube, is fully functional in most cases, since it is the two parts of the back panel which provide the material needed for the stretch which occurs when the cushion is sat upon.

In the final office action, Examiner has considered Applicant's argument that the first and second parts do not move, but states that these parts would necessarily have some degree of movement when a force is applied to the resilient material of the cover. It is submitted that this position is highly speculative. There is

no mention in either Cook or Reilly that would suggest that such movement occurs. Applicant's arguments are not to be understood as applied to an unmeasurable minuscule degree of movement allowed by the inherent resiliency of the material from which the cover is made. Applicant provides actual material in his back panel to allow a stretch when the cushion is sat upon, which material is retracted to provide a smooth appearance to the cover panel overlying the cushion when the user arises. No such movement is contemplated by either Cook or Reilly.

In page 5 of his final action, Examiner assures Applicant that he fully understands the invention. One indication that he does not is that during his first office action, he relied upon different art, and in his final action, he relies upon art which was no better than that which he originally applied.

Finally, Examiner recognizes that obviousness can be established only by combining some teaching, suggestion, or motivation to do so found either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art. In essence, he believes that there is motivation to combine the references but feels that the motivation is present.

In response, Applicant submits that invention generally involves two steps. A first is the formation of a concept of the general result wished for. A second is the actual reduction to practice of that concept. In many cases, once the first step is appreciated, the second step is relatively easy. It is submitted that this does not necessarily destroy the presence of inventive level required for the first step.

In conclusion, it is believed that Examiner has thoroughly searched the art, and the references upon which he is now relying are the best available. He has combined these teachings and added his own speculation in the light of Applicant's disclosure, which is not an obvious test for anticipation.

Respectfully submitted,



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CLAIMS APPENDIX

9. (Pending) A unitary cover for upholstered chairs and sofas comprising: a hollow shell of resilient fabric having a peripheral edge, an elastic member for contracting said edge to maintain said cover upon an engaged article of furniture, said cover including a plurality of interconnected panels overlying a rectangular cushion forming part of said article, said panels including a rear panel having first and second parts lying in separate planes disposed at a mutual angle to provide a degree of excess material in an area at the rear of said cushion; the material comprising said first and second parts being normally concealed from view and providing excess material for movement over said cushion when said cushion is sat upon by a user, said excess material contracting when said cushion is vacated.

10. (Pending) A cover in accordance with claim 9, wherein excess material formed by said first and second parts may be disposed beneath a lower edge of a back panel of said article concealed from view; and a resilient elongated tube positioned over said excess material to distribute stress over the width of said rear panel to provide a contractive force through said first and second parts.